

Appl. No. 09/869,359

Art Unit 1751

December 29, 2003

Reply to Office Action of September 30, 2003

REMARKS

Applicants thank the Examiner for the Interview conducted on September 24, 2003. Applicants believe the Interview has advanced prosecution for the present application.

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims.

Claim 2 was previously canceled. In the present amendment, claim 3 is canceled, and claims 7-13 have been added. Claim 1 has been amended. Thus, claims 1 and 4-13 are pending in the present application.

No new matter has been added by way of the amendment and new claims, because each amendment and new claim is supported by the present specification. For example, the amendment to claim 1 has support by canceled claim 3 and in the present specification at page 5, lines 13-16 and page 14, lines 9-14. New claim 7 is supported at page 4, lines 2-5 of the present specification. New claim 8 has support at page 5, lines 5-7. New claims 9-11 have support in the present specification at page 6, lines 4-13. New claim 12 is supported at page 9, lines 12-16. And support for new claim 13 is found at page 7, lines 15-16 and page 16, lines 20-21 of the specification. Thus, no new matter has been added.

The changes to the present specification are editorial in nature, and do not add new matter.

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Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues Under 35 U.S.C. §§ 102(b) and 103(a)

Claims 1 and 4-5 stand rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Williams et al. (U.S. Patent No. 4,239,640; hereinafter "Williams '640"). Also, claims 1 and 4-6 stand rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Cala (U.S. Patent No. 3,929,679; hereinafter "Cala '679"). Finally, claims 1 and 3-6 stand rejected under 35 U.S.C. § 103(a) as obvious over Kubota et al. (U.S. Patent No. 6,376,453; hereinafter "Kubota '453"). Applicants respectfully traverse, and reconsideration and withdrawal of all rejections are respectfully requested.

Each cited reference is asserted to disclose the features of the present invention. However, Applicants respectfully submit that none of the cited references discloses all features as instantly claimed. As agreed upon during the above-mentioned Interview, none of the references of Williams '640, Cala '679 and Kubota '453 disclose or

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recognize the instantly claimed features of contacting the raw material particles with an aqueous medium in the step of giving a defect to the coating film prior to supporting the surfactant. Applicants add that none of the cited references even disclose giving a defect to the coating film as instantly claimed. Thus, Applicants respectfully submit that all prior art rejections are instantly overcome.

Because "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," the cited Williams '640 and Cala '679 references cannot be a basis for a rejection under § 102(b). See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Thus, because of the lack of disclosure of all features as instantly claimed, the rejections in view of Williams '640 and Cala '679 are overcome.

In addition, Applicants respectfully submit that a *prima facie* case of obviousness requires that the prior art reference (or references when combined) must teach or suggest all the claim limitations. Here, Applicants respectfully submit that all rejections under § 103(a) are overcome since this requirement for a *prima facie* case of obviousness has not been satisfied. Applicants also submit that the requisite motivation and reasonable expectation of success are also lacking since none of the reference give any clear guidance or

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disclosure to one of ordinary skill in the art how to achieve the process as instantly claimed.

Also, with regard to newly added claims 7-13, these claims depend on claim 1. Thus, for the above-stated reasons, Applicants respectfully submit that these claims are patentably distinct from the cited references as well.

Accordingly, Applicants respectfully submit that the present invention is patentably distinct from the cited references. Thus, Applicants respectfully request the Examiner to reconsider and to withdraw all rejections and allow the currently pending claims.

Conclusion

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below.

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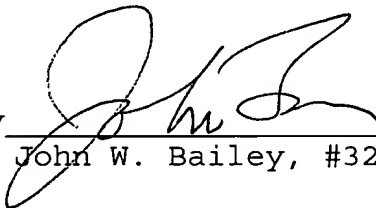
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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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